

Appl. No. 10/541,688
Amdt. Dated February 13, 2008
Reply to Office Action of November 14, 2007

...REMARKS...

The Official Action of November 14, 2007 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment, the limitations of dependent claim 8 have been incorporated into independent claim 1.

Dependent claim 8 has been canceled in favor of the incorporation thereof into independent claim 1.

In addition, dependent claim 9 has been changed to depend from claim 6 and to include language that is commensurate to the language of independent claim 1.

These changes to the claims are believed to be properly enterable after Final rejection inasmuch as they generally involve the incorporation of limitations from a dependent claim into an independent claim.

Entry of the changes to claims is respectfully requested

Claims 1-7 and 9-17 are pending in this application.

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Claims 1-7 and 9-17 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Japanese reference No. 2001-002864 to Shingo.

For the reasons set forth below, it is submitted that each of the pending claims are patentable over Shingo and therefore, the outstanding rejection of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

The Examiner has relied upon Shingo as teaching:

...an EPDM composition that contains an EPDM copolymer, organic peroxide, paraffinic process oil and a filler such as carbon black, silica, metal oxides or antioxidants. Examples 1-3 illustrate a composition having 100 parts of EPDM material with a Mooney viscosity of 28 at 100 deg. C, 80 parts of carbon black, 15 parts of a "paraffin series oil" and 3.5 parts of dicumyl peroxide. (pg. 2, para. 0014).

The present application and Shingo are commonly assigned. Accordingly, applicants are familiar with the teachings of Shingo.

Shingo discloses an EPDM composition that comprises peroxide crosslinkable EPDM, paraffinic process oil and an ester-based plasticizer. The EPDM composition further includes 0.5 to 10 parts by weight of organic peroxide, more than 15 parts by weight in total of the paraffinic process oil and the ester-based plasticizer (with the ester-based plasticizer being not more than 10 parts by weight itself). In addition to these essential ingredients, Shingo teaches the use of fillers such as carbon black and silica.

Applicants' independent claim 1, as amended herein, is limited to the use of carbon black.

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As demonstrated in applicants' working examples, when carbon black is used as a filler, the resulting seal molding material shows excellent electrolytic solution durability.

In contrast, when silica is used as a filler material (as shown in applicants' Example 7), the resulting seal molding material exhibits poor electrolytic solution durability.

Shingo discloses carbon black and silica as being equally suitable filler materials for producing an EPDM composition that has excellent low temperature characteristics and moldability.

However, Shingo fails to teach, recognize or render obvious the specific selection of carbon black as a filler material (to the exclusion of silica) for seal molding materials that are used for cell electrolytic solutions which seal molding materials have excellent electrolytic solution durability.

Accordingly, one skilled in the art reading Shingo would not have found it obvious to use carbon black as the exclusive filler material in an EPDM composition that is used at an electrode site of a nickel-hydrogen cell that contains an electrolytic solution.

In this regard, Shingo is completely silent as to the use of the disclosed EPDM compositions for use as seal molding materials in contact with electrolytic solutions.

In the *Response to Arguments* section of the Office Action the Examiner states:

Applicant's contend that Shingo fails to teach, recognize or render obvious the specific selection of carbon black as a filler material (to the exclusion of silica) for seal molding materials in a nickel-hydrogen cell that contains an electrolytic solution. The Examiner respectfully disagrees with Applicant's arguments. The Examiner notes that the instant claim language uses "comprising" claim language that would not necessarily exclude the use of silica in the claimed composition. Further, as stated in the previous Office Action, the Examples 1-3 illustrated in the Shingo reference do contemplate the use of carbon black only with no reference to the use of silica. The Examiner has enclosed a copy of an English translation of the Shingo

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reference provided by the translation services at the USPTO which reiterates the teachings disclosed in the earlier Office Action. Examples 1-3 on pgs.5-6 show a composition that contains 100 parts by weight of EPDM, 80 parts by weight carbon black, and 3.5 parts by weight of dicumyl peroxide with no mention of silica. Thus Examiner is unclear on Applicant's contention that the Shingo reference does not teach a composition using carbon black as the exclusive filler. With respect to the limitations regarding the use of the composition in nickel-hydrogen cells containing electrolytic solutions, the Examiner contends that these limitations are drawn to intended uses that are not given patentable weight and, further, since the compositions are identical in nature would be able to perform the same applications inherently.

It is noted that applicants' independent claim 1 recites "a filler which consists of carbon black."

It is believed that this language limits any filler in applicants' seal molding material to being only carbon black, i.e. excludes silica.

Applicants understand that Shingo provides examples in which only carbon black is used as a filler.

Note: applicants have not argued that Shingo reference does not teach a composition using carbon black as the exclusive filler - as the Examiner states.

What applicants content is that Shingo clearly teaches that either carbon black or silica can be used in the disclosed EPDM compositions. Moreover, Shingo teaches that the use of either carbon black or silica in EPDM compositions is equally suitable for purposes of producing an EPDM composition that has "excellent [for] low-temperature characteristic and forming process."

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What Shingo fails to recognize or teach is applicants' seal molding material that expressly limits the filler to carbon black and thereby provides a seal molding material that is resistant to surface deterioration when exposed to cell electrolytic solutions.

When silica is used in place of carbon black as the filler material in applicants' seal molding material, the resulting material shows poor electrolytic solution durability.

Thus, it is submitted that Shingo would not lead one skilled in the art to exclude the use of silica as a filler material and would moreover not at all teach or suggest that the compositions have any particular use as seal molding materials that are used at an electrode site of a nickel-hydrogen cell and exposed to an electrolytic solution.

The Examiner takes the position that the limitations regarding the use of applicants' composition in nickel-hydrogen cells containing electrolytic solutions are drawn to intended uses that are not given patentable weight.

Applicants' independent claim 1 recites, in part: "seal molding material for cell electrolytic solution **that is used at** an electrode site of a nickel-hydrogen cell."

This is not a recitation of an intended use.

Rather, claim 1 clearly recites the seal molding material being "**used at**" an electrode site of a nickel-hydrogen cell.

There is no intended use language such as "for use" at an electrode site of a nickel-hydrogen cell.

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Further, in addition to claiming the structural position/relationship of the seal molding material, claim 1 presently recites the characteristics/properties of the seal molding material which are a function of the use thereof "at" the electrode site of a nickel-hydrogen cell.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

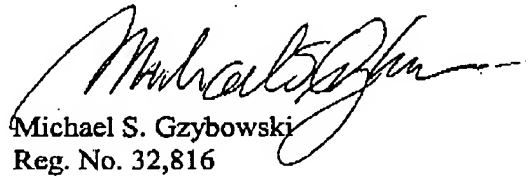
It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

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To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



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